

 **ALLERGAN**
LEGAL DEPARTMENT
2525 Dupont Drive
Irvine, California 92612

TO: Group 1626
US Patent/Trademark Office
Examiner R. Anderson
FAX 703-746-7444

FROM: Allergan, Inc.
Telephone-714-246-4920
FAX NO.: 714-246-4249
Carlos A. Fisher
DATE: August 28, 2003

cc:

Pages being sent including this cover page:

RE: Application Serial # 09/815,362
Filed: 03/21/2001

Our Reference: 17243CIP3(BAR)

CONFIDENTIAL / ATTORNEY CLIENT PRIVILEGED COMMUNICATION

The information contained in this transmission is privileged and confidential. It is intended only for the use of the individual or entity named below. If the reader of this message is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please notify Allergan immediately by telephone and return the original message to us at the above-indicated address via regular U.S. mail. Thank you.

This fax has been sent to one number only- please copy ALL OTHER addressees in your location/country.

☒ ORIGINAL WILL NOT FOLLOW

____ ORIGINAL WILL FOLLOW VIA:

____ Regular Mail
____ Overnight Delivery
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____ Other

Per our telephone conversation, enclosed are the amendments as filed on 6/12/2003 and 8/7/2003.

Thank you.

Carlos A. Fisher

MAIL STOP REPLY

Rec'd in USPTO/PCT Office. Date Stamp and Return Card.

Date: 8/7/2003

Serial No.: 09/815,362; Conf. No. 4078

Title:

Dkt. No.: COMPOUNDS AND METHODS OF TREATMENT...

Enclosed Are:

- | | |
|--|--|
| <input type="checkbox"/> Specification # _____, Claims # _____, and Abstract # _____ | <input type="checkbox"/> Declaration, Power of Attorney |
| <input type="checkbox"/> Drawings (_____ sheets) | <input type="checkbox"/> Assignment & Cover Sheet |
| <input type="checkbox"/> _____ Formal _____ Informal | <input type="checkbox"/> Amendment (Final) (# pgs. _____) |
| <input type="checkbox"/> Info. Disc. Statement | <input checked="" type="checkbox"/> Certificate of Mailing |
| <input type="checkbox"/> Priority Documents # _____ | <input type="checkbox"/> Issue Fee Transmittal |
| <input type="checkbox"/> PTO 1449 W/References | <input type="checkbox"/> Transmittal Letter |
| <input type="checkbox"/> PCT Request (# pgs. _____) | <input type="checkbox"/> Extension of Time |
| <input type="checkbox"/> PCT Demand (# pgs. _____) | <input type="checkbox"/> Express Mail No. _____ |
| <input type="checkbox"/> PCT Response (# pgs. _____) | |
| <input type="checkbox"/> PCT Amendment (# pgs. _____) | |

✓ REPLY
✓ COPIES OF LETTER
TO CORRECT INVENTORSHIP
OF 2/28/2002

MAIL STOP REPLY

Rec'd in USPTO/PCT Office. Date Stamp and Return Card.

Date: 8/7/2003

Serial No.: 09/815,362; Conf. No. 4078

Title:

Dkt. No.: COMPOUNDS AND METHODS OF TREATMENT...

Enclosed Are: 17243CIP3 (BAR)

- | | |
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| <input type="checkbox"/> Specification # _____, Claims # _____, and Abstract # _____ | <input type="checkbox"/> Declaration, Power of Attorney |
| <input type="checkbox"/> Drawings (_____ sheets) | <input type="checkbox"/> Assignment & Cover Sheet |
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| <input type="checkbox"/> PCT Amendment (# pgs. _____) | |

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OF 2/28/2002

DOCKET NO. 17243CIP3(AP)
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of
Chow et al

Group Art Unit: 1626

Serial No: 09/815,362
Conf. No. 4078
Filed: March 21, 2001

Examiner: Anderson, R.

For: COMPOUNDS AND METHODS OF
TREATMENT HAVING AGONIST-LIKE
ACTIVITY SELECTIVE AT ALPHA 2B
OR 2B/2C ADRENERGIC RECEPTORS

REPLY TO OFFICE COMMUNICATION

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:


This communication is being filed in reply to the Office Communication date
mailed 02/12/2003.

Please note that the change in inventorship should read Dario G. Gomez. I am
enclosing copies of the supporting documents.

Kindly use Deposit Account 01-0885 for payment of any fee that may be due in
connection ;with this communication.

Date: 8/16/03

Respectfully Submitted,


Carlos A. Fisher
Reg. No. 36,510
ALLERGAN, INC.
T2-7H

2525 Dupont Drive
Irvine, CA 92612

Tel: 714-246-4920/Fax: 714-246-4249

CERTIFICATE OF MAILING
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS EXPRESS MAIL POST
OFFICE TO ADDRESSEE IN AN ENVELOPE MARKED FIRST CLASS TO: MAIL STOP REPLY-NON-FEE COMMISSIONER FOR PATENTS, P.O. BOX 1450,
P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on 8/17/03 Signature of Person Making Deposit: [Signature]
Date: 8/17/03 Printed Name of Person Making Deposit: Bonnie Ferguson

Aug-28-03 11:07am From-ALLERGAN LEGAL DEPARTMENT

+17142464249

T-797 P.04

F-363



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,362	03/21/2001	Ken Chow	17243CIP3(MP)	4078

7590

02/12/2003

Carlos A. Fisher
ALLERGAN, INC.
T2-2E
2525 Dupont Drive
Irvine, CA 92623

(BAR)

EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 02/12/2003

COPY

Please find below and/or attached an Office communication concerning this application or proceeding.

RESPONSE DUE March 14 2003
ACTION Amendment
(5-12)

Office Action Summary

Application No.

09/815,362

Applicant(s)

CHOW ET AL.

Examiner

Rebecca L Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 108 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-4, 7-15, 20, 21, 26, 38, 50-55, 71, 89, 97, 101, 103 and 104 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Aug-28-03 11:07am From-ALLERGAN LEGAL DEPARTMENT

+17142464249

T-797 P.06/27 F-363

Continuation Sheet (PTO-326)

Application No. 09/815,362

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5,6,16-19,22-25,27-37,39-45,47-49,56-70,72-88,90-96,98-100,102 and 105-107.

Application/Control Number: 09/815,362
Art Unit: 1626

Page 2

DETAILED ACTION

Claims 1-108 are currently pending in the instant application (Note: Page 4 of Amendment B filed 3 May 2002 states, "Applicant notes that claim 109, added by amendment in the communication, stands unrejected." However, no amendment adding a claim 109 is found in amendment B or amendment A, filed 20 December 2001. Therefore, claims 1-108 are currently pending in the instant application.) Claim 108 is allowable over the prior art of record. Claims 1-4, 7-15, 20, 21, 26, 38, 46, 50-55, 71, 89, 97, 101, 103 and 104 are objected to as containing non-elected subject matter. Claims 5, 6, 16-19, 22-25, 27-37, 39-45, 47-49, 56-70, 72-88, 90-96, 98-100, 102 and 105-107 are withdrawn from consideration as being drawn to non-elected inventions.

Inventorship

In view of the papers filed 12 March 2002, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Dario M. Gomez as a joint inventor

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Specification

The disclosure is objected to because of the following informalities: page 128 is missing.

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Art Unit: 1626

Page 3

Appropriate correction is required.

Election/Restrictions

Applicant's election of the species of N3, found on page 102 of the instant specification, in Paper No. 13 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

With the identification of the above noted species, the examiner will identify a generic concept, inclusive of said species, for examination.

The generic concept is that of the compound as found in claim 1 wherein:

x is 1 or 2;

R₁ is independently selected from the group consisting of H; halogen; C₁₋₄alkyl; C₁₋₄alkenyl; C₁₋₄alkynyl; --COR₄ where R₄ is H, C₁₋₄alkyl or C₁₋₄alkoxy; C₃₋₆cycloalkyl; aryl, cyano, nitro; trihalomethyl; oxo; or --(CH₂)_n-X-(CH₂)_m-(R₅)_o where X is O, S or N, n is 0-3, m is 0-3, o is 0-1, and R₅ is methyl or H₁₋₂;

R₂ and R₃ together consist of a partly saturated ring structure containing one double bond, wherein the double bond is shared with the ring including Y, having the formula --(C(R₆)_p)_q-X_s-(C(R₆)_p)_r-X_t-(C(R₆)_p)_u where each R₆ is independently selected from the group consisting of H; halogen; C₁₋₄alkyl; C₁₋₄alkenyl; C₁₋₄alkynyl; --COR₄ where R₄ is H, C₁₋₄alkyl or C₁₋₄alkoxy; C₃₋₆cycloalkyl; aryl; cyano; nitro; trihalomethyl and oxo where each p is independently 1 or 2; q is 0-4, r is 0-4, u is 0-4; each X is independently O, S or N and s is 0; t is 0; provided that q + r + u + s + t is 4;

Application/Control Number: 09/815,362
Art Unit: 1626

Page 4

and the ring including Y is a cyclohexane ring containing one double bond, which is shared with the ring formed by R2 and R3.

The remaining subject matter of claims 1-4, 7-15, 20, 21, 26, 38, 46, 50-55, 71, 89, 97, 101, 103 and 104 and the subject matter of claims 5, 6, 16-19, 22-25, 27-37, 39-45, 47-49, 56-70, 72-88, 90-96, 98-100, 102 and 105-107 stands withdrawn, 37 CFR 1.142(b), as being for non-elected inventions. The withdrawn subject matter of the claims is properly restricted as said subject matter differs materially in structure and element from the elected subject matter so as to be patentably distinct, i.e. a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Additionally, the fields of search are not co-extensive.

Accordingly, the claims are drawn to more than a single invention and restriction as has been required is proper, 37 CFR 1.142(a).

Claim Objections

Claims 1-4, 7-15, 20, 21, 26, 38, 46, 50-55, 71, 89, 97, 101, 103 and 104 are objected to as containing non-elected subject matter. The claims presented drawn solely to the elected subject matter as indicated supra would appear allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.


Application/Control Number: 09/815,362
Art Unit: 1626

Page 5


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



Rebecca Anderson
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600



Joseph McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

COPY

Box: PETITION TO CHANGE INVENTORSHIP
 Rec'd in USPTO/PCT Office. Date Stamp and Return Card.
 Date: *2/28/2002* Serial No.: *09/815,362*
 Title: *COMPOUNDS AND METHODS OF TREATMENT*
 Dkt. No.: *17243CIP3(BAR)*

Enclosed Are:

- | | |
|--|--|
| <input type="checkbox"/> Specification # _____, Claims # _____
and Abstract # _____ | <input checked="" type="checkbox"/> Declaration, Power of Attorney |
| <input type="checkbox"/> Drawings (____ sheets)
____ Formal ____ Informal | <input type="checkbox"/> Assignment & Cover Sheet |
| <input type="checkbox"/> Info. Disc. Statement | <input type="checkbox"/> Amendment (Final) (# pgs. _____) |
| <input type="checkbox"/> Priority Documents # _____ | <input type="checkbox"/> Certificate of Mailing |
| <input type="checkbox"/> PTO 1449 W/References | <input type="checkbox"/> Issue Fee Transmittal |
| <input type="checkbox"/> PCT Request (# pgs. _____) | <input type="checkbox"/> Transmittal Letter |
| <input type="checkbox"/> PCT Demand (# pgs. _____) | <input type="checkbox"/> Extension of Time |
| <input type="checkbox"/> PCT Response (# pgs. _____) | <input type="checkbox"/> Express Mail No. _____ |
| <input type="checkbox"/> PCT Amendment (# pgs. _____) | <input checked="" type="checkbox"/> <i>PETITION</i> |
| | <input checked="" type="checkbox"/> <i>CONSENT</i> |
| | <input checked="" type="checkbox"/> <i>STATEMENT</i> |

Box: PETITION TO CHANGE INVENTORSHIP
 Rec'd in USPTO/PCT Office. Date Stamp and Return Card.
 Date: *2/28/2002* Serial No.: *09/815,362*
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| <input type="checkbox"/> Specification # _____, Claims # _____
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| <input type="checkbox"/> PCT Amendment (# pgs. _____) | <input checked="" type="checkbox"/> <i>PETITION</i> |
| | <input checked="" type="checkbox"/> <i>CONSENT</i> |
| | <input checked="" type="checkbox"/> <i>STATEMENT</i> |

DOCKET NO. 17243CIP3(AP)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Chow et al.

Serial No.: 09/815,362

Filed: March 21, 2001

For: COMPOUNDS AND METHOD OF
TREATMENT HAVING AGONIST-LIKE ACTIVITY SELECTIVE
AT ALPHA 2B OR 2B/2C ADRENERGIC RECEPTORSExaminer: Floyd D. Higel
Art Unit: 1626

I hereby certify that this correspondence is
being deposited with the United States
Postal Service as first class mail in an
envelope addressed to: Box Petition to
Correct Inventorship, Assistant
Commissioner for Patents, Washington,
D.C. 20231 on:

2/28/02

(Date of Deposit)

BONNIE FERGUSON
Printed Name of Person Making
Deposit

Bonnie Ferguson
Signature

2/28/2002
Date of Signature

PETITION FOR CORRECTION OF INVENTORSHIP

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants hereby petition the Commissioner pursuant to 37 CFR 1.48(a) to correct the inventorship in the above-referenced patent application. Through error, inventor Dario M. Gomez was not named as a joint inventor when this continuation patent application was filed. This error was made by the undersigned without deceptive intent in the haste to file the present application; such haste was exacerbated by the fact the undersigned was simultaneously working without an experienced assistant at the time, a lack that has thankfully since been cured.

Accordingly, Applicants petition the Commissioner to amend the application to set forth the actual inventors. Accompanying this petition is 1) a Statement of Dario M. Gomez in support of the correction of inventorship, 2) a Declaration by the actual inventors as required by 37 CFR §1.63, and 3) the written consent of the assignee, Allergan Sales, Inc., for such correction of inventorship.

Serial No. 09/815,362
Docket No. 17243CIP3 (AP)

2

Kindly use Deposit Account 01-0885 for the payment of the petition fee and any other cost that may be due as a result of this communication.

Respectfully submitted,

Dated: 2/27/07

By: 

Carlos A. Fisher- T2-7H
Registration No. 36,510
Attorney of Record
ALLERGAN, INC.
Legal Department
2525 Dupont Drive
Irvine, CA. 92612

Telephone: (714) 246-4920
Facsimile: (714) 246-4249

PATENT

DOCKET NO. 1/243CIP3(AP)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Chow et al.
 Serial No.: 09/815,362; Conf. No. 4078
 Filed: March 21, 2001
 For: COMPOUNDS AND METHOD OF
 TREATMENT HAVING AGONIST-LIKE ACTIVITY SELECTIVE
 AT ALPHA 2B OR 2B/2C ADRENERGIC RECEPTORS
 Group Art Unit: 1626
 Examiner: Floyd D. Higel
 Art Unit:)1626

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Patent to Correct Inventorship, Assistant Commissioner for Patents, Box Inventorship Correction, Washington, D.C. 20231

2/28/2002
 (Date of Deposit)

BONNIE FERGUSON
 Printed Name of Person Making Deposit

Bonnie Ferguson
 Signature
2/28/2002
 Date of Signature

CONSENT OF ASSIGNEE TO CORRECTION OF INVENTORSHIP

Assistant Commissioner for Patents
 Washington, D.C. 20231

Dear Sir:

As owner of the entire right, title, and interest in the above identified patent application, ALLERGAN hereby consents to the correction of inventorship to add Dario G. Gomez as an inventor in the above-referenced patent application. ALLERGAN'S right to take action pursuant to 37 CFR 3.73 is established in an Assignment from the inventors to ALLERGAN recorded in the Patent and Trademark Office on August 16, 1996 at Reel 8135, Frame 0552.

I, the undersigned, declare that I am authorized to make this appointment on behalf of Allergan Sales, Inc.

Respectfully submitted,

Martin A. Voet
 Martin A. Voet
 Assistant Secretary
 Allergan Sales, Inc.
 2525 Dupont Drive
 Irvine CA 92612

DOCKET NO. 17243CIPS(AP)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Chow et al.
 Serial No.: 09/815,362; Conf. No. 4078
 Filed: March 21, 2001
 For: COMPOUNDS AND METHOD OF
 TREATMENT HAVING AGONIST-LIKE ACTIVITY SELECTIVE
 AT ALPHA 2B OR 2B/2C ADRENERGIC RECEPTORS
 Group Art Unit: 1626
 Examiner: Floyd D. Higel

I hereby certify that this correspondence is being
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 first class mail in an envelope addressed to:
 Assistant Commissioner for Patents, Box
 Inventorship Change, Washington, D.C. 20231 on:

2/28/2002
 (Date of Deposit)

BONNIE FERGUSON
 Printed Name of Person Making Deposit

Bonnie Ferguson
 Signature

2/28/2002
 Date of Signature

STATEMENT OF DARIO G. GOMEZ

Assistant Commissioner for Patents
 Washington, D.C. 20231

Dear Sir:

I, Dario G. Gomez, am an inventor of the subject matter claimed in the above-referenced patent application.

At the time the invention was made I was employed by Allergan, Inc., the parent company of the assignee Allergan Sales, Inc. I was unaware that this continuing application was filed until after the filing date, and therefore had no opportunity to advise Allergan that the inventor information, including the list of inventors, was incomplete. Thus, the incorrect naming of the inventive entity in this patent application was made without deceptive intent on my part; moreover, it is my understanding that such incorrect indication of inventors was an inadvertent error made when the patent application was filed.

Respectfully submitted,

Dated: 02/14/02

By: [Signature]
 Dario G. Gomez

Chow et al.
Docket No. 17243CIP3(AP)
Filed: March 21, 2001)

COMBINED DECLARATION & POWER OF ATTORNEY - U.S.A Application

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention **COMPOUNDS AND METHODS FOR TREATING PAIN AND INTRAOCULAR HYPERTENSION WITH REDUCED SIDE EFFECTS** the specification of which

(check one) ☐ is attached hereto
☒ was filed on 3/21/02 as US Application Serial No. 08/815,362
or PCT International Application No. _____
and was amended on _____ (if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a). I hereby claim foreign priority benefits under 35 USC § 119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the Prior Foreign Applications(s).

<u>Number</u>	<u>Country</u>	<u>Day/Month/Yr filed</u>	<input type="checkbox"/> Priority Not Claimed
---------------	----------------	---------------------------	---

I hereby claim the benefit under 35 USC §119 (e) of any United States provisional application(s) listed below.

<u>Application No.</u>	<u>Filing Date</u>
------------------------	--------------------

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application(s) in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

<u>09/329,752</u> Application No.	<u>June 6, 1999</u> Filing Date
<u>09/205,597</u> Application No.	<u>December 4, 1998</u> Filing Date
<u>08/895,347</u> Application No.	<u>December 4, 1997</u> Filing Date


Chow et al.
Docket No. 17243CIP3(AP)
Filed: March 21, 2001

I hereby appoint **CARLOS A. FISHER**, Registration No. 36,510 (to whom all communications are to be directed), and the below-named persons (of the same address) individually and collectively my attorneys to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith and with the resulting patent, with full power to appoint associate attorneys:


Name	Registration No.
Robert Baran	25,806
Stephen Donovan	33,433
Martin A. Voet	25,208


, all of the following correspondence address: **Allergan, Inc., 2525 Dupont Drive, Irvine, CA. 92612**

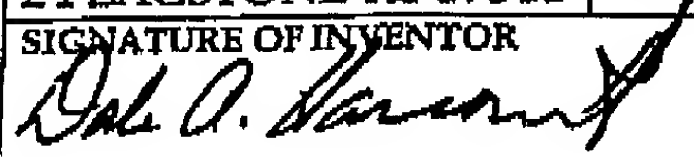
I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR:			
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Chow et al.
Docket No. 17243CIP3(AP)
Filed: March 21, 2001)

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Chow et al.
Docket No. 17243CIP3(AP)
Filed: March 21, 2001)

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SIGNATURE OF INVENTOR <i>Larry A. Wheeler</i>		DATE: 24 Jan 02	
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SIGNATURE OF INVENTOR		DATE:	

Chow et al.
Docket No. 17243CIP3(AP)
Filed: March 21, 2001)

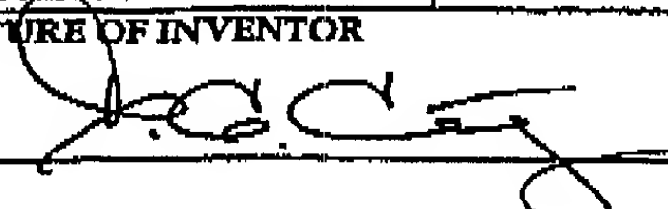
FULL NAME OF INVENTOR:			
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SIGNATURE OF INVENTOR 		DATE: <i>5 October 2007</i>	

4 A

Chow et al.
Docket N . 17243CIP3(AP)
Filed: March 21, 2001)

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MAIL STOP AMENDMENT-FEE
Rec'd in USPTO/PCT Office. Date Stamp and Return Card.
Date: *6/12/2003* Serial No.: *09/815 362i* Cont. NO. *4078*
Title: *COMPOUNDS AND METHOD OF TREATMENT HAVING...*
Dkt. No.: *1724301P3(AP)*
Enclosed Are:

<input type="checkbox"/> Specification # _____, Claims # _____, and Abstract # _____	<input type="checkbox"/> Declaration, Power of Attorney
<input type="checkbox"/> Drawings (____ sheets) _____ Formal _____ Informal	<input type="checkbox"/> Assignment & Cover Sheet
<input type="checkbox"/> Info. Disc. Statement	<input type="checkbox"/> Amendment (Final) (# pgs. _____)
<input type="checkbox"/> Priority Documents # _____	<input checked="" type="checkbox"/> Certificate of Mailing
<input type="checkbox"/> PTO 1449 W/References	<input type="checkbox"/> Issue Fee Transmittal
<input type="checkbox"/> PCT Request (# pgs. _____)	<input checked="" type="checkbox"/> Transmittal Letter
<input type="checkbox"/> PCT Demand (# pgs. _____)	<input checked="" type="checkbox"/> Extension of Time <i>-one month</i>
<input type="checkbox"/> PCT Response (# pgs. _____)	<input type="checkbox"/> Express Mail No. _____
<input type="checkbox"/> PCT Amendment (# pgs. _____)	<input checked="" type="checkbox"/> <i>Page 128</i>

MAIL STOP AMENDMENT-FEE
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Date: *6/12/2003* Serial No.: *09/815 362i* Cont. NO. *4078*
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Dkt. No.: *1724301P3(AP)*
Enclosed Are:

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<input type="checkbox"/> PCT Response (# pgs. _____)	<input type="checkbox"/> Express Mail No. _____
<input type="checkbox"/> PCT Amendment (# pgs. _____)	<input checked="" type="checkbox"/> <i>Page 128</i>

U.S. PATENT & TRADEMARK OFFICE
JOINT PCT RECEIPT
JUN 17 2003

PATENT
Docket No. 17243CIP3
Serial No. 09/815,362
Conf. No. 4078

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: CHOW ET AL

Serial No: 09/815,362

Filed: March 21, 2001

For: COMPOUNDS AND METHOD OF TREATMENT
HAVING AGONIST-LIKE ACTIVITY SELECTIVE AT
ALPHA 2B OR 2B/2C ADRENERGIC RECEPTORS

Group Art Unit: 1626

Examiner: Rebecca L. Anderson

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Amendment in the above-identified application. Enclosed
are:

- 1) Postcard
- 2) Transmittal Letter (2 pgs.)
- 3) Reply to Office Action (3 pgs.)
- 4) Page 128

CERTIFICATE OF EXPRESS MAILING	
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE WITH SUFFICIENT POSTAGE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: MAIL STOP AMENDMENT-FEE, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 ON	
6/12/03 (Date)	Name of person making deposit: BONNIE FERGUSON
Signature: <i>Bonnie Ferguson</i>	Dated: 6/12/03

PATENT
Docket No. 17243CIP3
Serial No. 09/815,362
Conf. No. 4078

The fee has been calculated as shown below:

CLAIMS AS FILED

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
Total Claims	108	MINUS	234	= 0 x	\$18	= \$0.00
Independent Claims	2	MINUS	3	= 0 x	\$84	= \$0.00
If application has been amended to contain multiple dependent claim(s), then add				No	\$280	= \$0.00
(Select only one)				one month	\$110	= \$110.00
Time Extension Fees:				two months	\$410	= \$*
				three months	\$930	= \$*
				four months	\$1,450	= \$*
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$110.00

- () A check in the amount of \$* is enclosed (place fee in here i.e., petition, excess claims, etc.)
- (x) The Commissioner is hereby authorized to charge fees under 37 CFR 1.16 and 1.17 (associated with petition fees or excess claim fees) which may be required, or credit any overpayment to Deposit Account No. 01-0885. A duplicate copy of this sheet is enclosed.

Respectfully Submitted,

Date:

6/12/03

Signature:



Carlos A. Fisher
Registration No. 36,510
Legal Department, T2-2E
ALLERGAN, INC.
2525 Dupont Drive
Irvine, CA 92623-9534
Telephone: (714) 246-4920
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PATENT

17243 CIP3

Chow et al.

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alkoxy; C₃₋₆ cycloalkyl; aryl; heteroaryl; cyano; nitro; trihalomethyl; and oxo where each p is independently 1 or 2, q is 0-4, r is 0-4, u is 0-4; each X is independently O, S, or N, s is 0 or 1, and $q + s + r + t + u = 3$ or 4.

5 27. The compound of claim 26 in which at least one of s and t equals 1.

28. The compound of claim 27 in which $q + r + s + t + u$ equal 3.

29. The compound of claim 28 in which an X equals S.

10

30. The compound of claim 28 in which an X equals O.

31. The compound of claim 28 in which an X equals N.

15 32. The compound of claim 27 in which $q + r + s + t + u$ equal 4.

33. The compound of claim 32 in which an X equals S.

34. The compound of claim 32 in which an X equals O.

20

35. The compound of claim 32 in which an X equals N.

25 36. The compound of either of claims 28 or 32 in which at least one R₆ is selected from the group consisting of halogen; C₁₋₄ alkyl; C₁₋₄ alkenyl; C₁₋₄ alkynyl; --COR₄ where R₄ is H; C₁₋₄ alkyl or C₁₋₄ alkoxy; C₃₋₆ cycloalkyl; aryl; heteroaryl; trihalomethyl; $-(CH_2)_n-X-(CH_2)_m-(R_5)_o$ where X is O, S or N, n is 0-3, m is 0-3, o is 0-1, and R₅ is methyl or H₁₋₂; and oxo.

Aug-28-03 11:13am From-ALLERGAN LEGAL DEPARTMENT

+17142464249

T-797 P.26/27 F-363

In Re Application of
Chow et al

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DOCKET NO. 17243CIP3(AP)
PATENT

Serial No: 09/815,362; Conf. No. 4078
Filed: March 21, 2001

Group Art Unit: 1626

Examiner: Anderson, R.

For: COMPOUNDS AND METHODS OF TREATMENT HAVING
AGONIST-LIKE ACTIVITY SELECTIVE AT ALPHA 2B OR 2B/2C
ADRENERGIC RECEPTORS

REPLY TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This communication is being filed in reply to the Office Action mailed February 12, 2003. After careful review, Applicants have the following comments. Claims 1-108 are currently pending.

CERTIFICATE OF MAILING
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS EXPRESS MAIL POST
OFFICE TO ADDRESSEE IN AN ENVELOPE MARKED FIRST CLASS TO: MAIL STOP AMENDMENT-FEE ASSISTANT COMMISSIONER FOR PATENTS,
P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on 6/12/03 Signature of Person Making Deposit: *Forrest Ferguson*
Date: 6/12/03 Printed Name of Person Making Deposit: *Forrest Ferguson*

Received from <+17142464249> at 8/28/03 2:11:34 PM [Eastern Daylight Time]

REMARKS

Applicants note with gratitude the Examiner's indication that claim 108 is allowable, and that claims 1-108 stand unrejected.

Specification

Applicant regret any inconvenience caused by missing page 128 of the specification. Applicants herewith enclose a copy of page 128 of the specification as requested by the Examiner.

Election of Species

In the Office Action of November 6, 2002 the Examiner made an election of species requirement pursuant to 37 CFR 1.146, requesting that the Applicants elect a single compound for examination purposes. Accordingly Applicants elected the species labeled "N3" on page 102 of the specification to facilitate examination of the identified genus (i.e., that genus encompassed by claim 1 as identified by the Examiner on page 2 of the November Office Action.

The Examiner's most recent Office Action of February 12, 2003 now states "because applicant did not distinctly and specifically point out the supposed errors *in the restriction requirement*, the election [of species N3] has been treated as an election without traverse." (Office Action of February 12, 2003, emphasis added.)

The Examiner has not made a restriction requirement; Applicant responded to an election of species requirement when responding to the February Office Action; this election of species requirement was unaccompanied by a restriction requirement. 37 CFR 1.146, entitled "Election of Species" states in relevant part:

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted *if no claim to the genus is found to be allowable*.

(Emphasis added)

Thus, the ~~election~~ of species requirement requires the Examiner to examine the applicant's generic claim (claim 1 in the case) as it applies to the elected species. If, under such circumstances the generic claim is found to be allowable, MPEP 809.02(c)(B)(1) states that when all claims to each of the additional species are embraced by an allowable generic claim, applicant must be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim.

With respect, not only has the Examiner erroneously failed to so advise and to rejoin the non-elected species for examination, but has actually 1) formulated her own "generic claim" (the proposition of which Applicant has not had a chance to accept or object), and 2) withdrawn all claims not encompassed by this "generic claim". Applicants find no support in the patent statute or rules for such action.

Aug-28-03 11:14am From-ALLERGAN LEGAL DEPARTMENT

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T-797 P.01/01 F-364

Docket No. 17243CIP3(AP)
Serial No. 09/815,362; Conf. No. 4078

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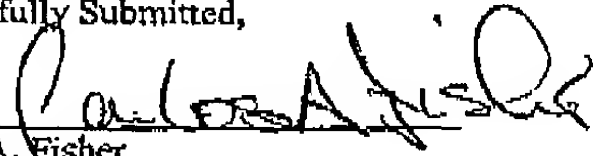
If the Examiner wishes to make a restriction requirement, Applicant respectfully requests that the Examiner formally make such a requirement, permitting Applicant the opportunity to respond thereto.

Kindly use Deposit Account 01-0885 for payment of any fee that may be due in connection ;with this communication, including fees due in connection with as petition for extension of the time required to respond to the outstanding Office Action.

Date:

6/12/03

Respectfully Submitted,


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